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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/703,562	11/01/2000	William C O'Neil, Jr.	TFUND-4809	3102
72960	7590	08/18/2008		
Casimir Jones, S.C. 440 Science Drive Suite 203 Madison, WI 53711			EXAMINER MYHRE, JAMES W	
			ART UNIT 3688	PAPER NUMBER
			MAIL DATE 08/18/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/703,562

Applicant(s)

O'NEIL, JR. ET AL.

Examiner

JAMES W. MYHRE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-8, 13-16, 24, 25, 29-32, and 49-56 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 4-8, 13-16, 24, 25, 29-32, and 49-56 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/3508)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

DETAILED ACTION

1. The Office Action dated July 29, 2008 is hereby vacated. This Office Action is in full response to the Amendment filed on May 9, 2008.

Response to Amendment

2. Upon entry of the Amendment, Claims 2, 3, 9, 10, 12, 17-23, 26-28, and 33-48 have been cancelled; Claims 1, 7, 24, 29, 49, 50, and 53 have been amended; and new Claims 55 and 56 have been added. Thus, the currently pending claims considered below are Claims 1, 4-8, 13-16, 24, 25, 29-32, and 49-56.

Specification

3. The disclosure is objected to because of the following informalities: numerous inconsistencies exist between the reference numbers in the figures and in the text of the specification. For example, Figure 1 identifies "Money Manager 110". Whereas in the specification Money Manager is referred to as Money Manager 110 (page 10, lines 1 and 2) and as Money Manager 100 in at least eight places on pages 12 and 13.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4-8, 13-16, 24, 25, 29-32, and 49-56 are rejected under 35 U.S.C.

103(a) as being unpatentable over Hartt et al (WO 94/04979 A1) in view of Fernandez-Holmann (5,787,404).

Claims 1, 24, 49, 50-53, 55, and 56: Hartt discloses a system and method for using transaction rebates to fund a customer's investment account, comprising:

- a. providing an investment account (page 4, lines 13-16 and page 5, lines 24-25);
- b. providing at least one registered merchant (participating vendor)(page 2, lines 18-21; page 3, lines 5-7; and page 6, lines 10-19);
- d. providing a rebate network manager (system processor) in which the accounts are registered (Figure 1, item 1);
- e. monitoring sales by the merchant to determine when qualifying sales are consummated (page 3, lines 3-16);
- f. calculating a rebate on each purchase made from the merchant based on an existing rebate formula (page 3, lines 3-16 and page 6, lines 13-19); and
- g. updating the accounts (debiting and crediting) with the rebate amount (page 4, lines 5-9).

Hartt does not explicitly disclose issuing the customer a credit or debit card and limiting the monitored sales to transactions conducted using the credit or debit card, nor

that the funds in the account will be used to pay for loans, debts, etc. However, Fernandez-Holmann discloses a similar system and method for using credit/debit cards to fund a customer's investment account by providing credit/debit card accounts (Figure 4, item s1; Figure 5, item 2; column 2, line 56 – column 3, line 4; and column 4, lines 35-44); monitoring sales using the credit/debit cards (Figure 4; column 2, line 56 – column 3, line 4; and column 5, line 48 – column 6, line 3); and using the balance in the investment account to pay for loans, debts, etc. (column 4, line 51-57 and column 8, lines 31-36). Furthermore, Official Notice is taken that it was old and well known to conduct transaction using credit or debit cards at the time of invention. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Hartt to base the system on credit/debit card transactions at the merchant. One would have been motivated to use credit/debit card transactions in order to allow easy identification of the customer (through the use of the card number) without requiring the customer to carry a separate identification card. One would have been motivated to use the funds in the investment account to pay for loans, debts, etc. since that is the intended use of any investment account – to pay for a product or service in the future.

While Hartt discloses the investment account can be any of a variety of investment vehicles, such as fixed rate annuities, variable-rate annuities, equity-based mutual fund, or a bond-based mutual fund, it is not explicitly disclosed that the purpose of the fund is for educational savings. However, Official Notice is taken that it is old well known to set up education accounts to save money for future educational costs. For

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example, Lidman (5,471,669) discloses a system using coupon rebates for funding an “account to be used for educational or other purposes” (Abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that any investment account, long term or short term, and including an account intended to support education pursuits, could be used in the Hartt system. The Examiner further notes that the intended use of the accumulated funds is considered by the Office to be just that – intended use. Thus, it is given little, if any, patentable weight. One would have been motivated to select an educational investment fund in view of the spiraling cost of higher education and the need to plan ahead for such costs.

Hartt further discloses the rebate being paid by the merchant (“the vendor may transfers only a 3% rebate of each subscriber’s purchase to the escrow account for one year.” (page 6, lines 13-16)

Claim 4: Hartt and Fernandez-Holmann disclose a method as in Claim 1 above, and Hartt further discloses the investment account database and the computer processor are connected together via a computer network (Figure 1).

Claim 5: Hartt and Fernandez-Holmann disclose a method as in Claim 1 above, and Hartt further discloses crediting the investment account using a computer processor (Figure 1).

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Claims 6, 25, and 54: Hartt and Fernandez-Holman disclose a system and method as in Claims 1, 24, and 53 above, but do not explicitly disclose the specific claimed types of educational accounts. However, since these are all well-known types of accounts, and since it has been previously established above that the type of investment account into which the rebates are credited is being given little, if any, patentable weight, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Hartt to include any or all of the claimed types of investment accounts. One would have been motivated to include these types of accounts in order to allow the customer to choose the type of account best suited for their needs.

Claim 7: Hartt and Fernandez-Holmann disclose a method as in Claim 1 above, and Hartt further discloses managing the investment account (page 3, line 13-28).

Claim 8: Hartt and Fernandez-Holmann disclose a method as in Claim 1 above, and Fernandez-Holmann further discloses that the investment account will be credited with an amount equal to the rebate (column 2, line 56 – column 3, line 4 and column 6, lines 14-19) and Hartt discloses the rebate network manager charges (deducts) processing fees from the rebate amount; thus, crediting the investment account with less than the full rebate amount (page 5, lines 26-28).

Claims 13, 14, 31, and 32: Hartt and Fernandez-Holmann disclose a system and method as in Claims 1 and 24 above, but do not explicitly disclose where the sales

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transaction is taken place, on-line or on-site. However, on-line sales using credit or debit card were old and well known at the time the invention was made, and on-site sales have been used for millennium. Since the location of the sale does not affect the processing of the rebate through the computer system, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Hartt to use sales data from transaction being performed on-line, on-site, or both. One would have been motivated to use sales data from both on-line and on-site transaction in order to provide coverage for all transactions being conducted by the customer using the credit or debit card.

Claim 16: Hartt and Fernandez-Holmann disclose a method as in Claim 1 above, and Hartt further discloses the registration organization receives a portion of the rebate (page 5, lines 26-28).

Response to Arguments

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Lidman (5,471,669) discloses a system and method for funding an education account using rebates from coupons redeemed during sales transactions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Supervisory Patent Examiner James W. Myhre, whose telephone number is 571-272-6722. The examiner can normally be reached from 5:15 a.m. - 3:45 p.m. Monday through Thursday. The fax telephone number for all formal fax communications is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/J. W. M./
August 12, 2008

/James W Myhre/
Supervisory Patent Examiner, Art Unit 3688